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11/09/2005

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EXAMINER

VIG, NARESH

ART UNIT

PAPER NUMBER

3629

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Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/378,159	<b>Applicant(s)</b> PATTON ET AL.	
	<b>Examiner</b> Naresh Vig	<b>Art Unit</b> 3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02 September 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1 - 4, 6 - 26 and 28 - 32 and 34 - 55 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 - 4, 6 - 26 and 28 - 32 and 34 - 55 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

This is in reference to Request For Continued Examination 02 September 2005.

There are 52 claims, i.e. claims 1 – 4, 6 – 26 and 28 – 32 and 34 – 55 are pending for examination.

#### ***Response to Arguments***

In response to applicant's argument that cited reference USPS there is no teaching or suggestion of customizing the images or providing of information to the user for allowing display and/or customization of images used in an affixed postal product at the remote ordering system.

However, Stephen teaches allowing display and/or customization of images used in an affixed postal product at the remote ordering system.

In response to applicant's argument that the photographer therein is a part of the issuing authority that reviews whether or not images are appropriate for incorporation into an official postal stamp. Stephens reference does not teach that the image is a part of the official postal stamp as taught and claimed by Applicant.

However, Stephen teaches that stamps are issued by Australia Postal authority. Therefore, stamps issued are official postal stamps.

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In response to applicant's argument that third paragraph of the Stephens article teaches that photo tabs must at all times remain affixed to the stamp to be postal valid. Thus, it is clear that the Stephens article does not teach the providing of customized images an integral part of the postal stamp, but a separate tab.

However, Stephen shows an image of customized postal stamp. Applicant has not claimed that the customized portion of the customized stamp cannot be separated.

In response to applicant's argument that Brackney reference does not teach or suggest ordering of custom images over a communication network but discloses the submission of a personal image for incorporation as a standard official postal stamp.

However, Brackney teaches that an image to be incorporated in a postal stamp can be electronically submitted to the postal authority over a communication network.

In response to applicant's argument that the USPS reference is directed simply to the ordering of stamps. There is no teaching of customizing of personal images or providing of instructions for customizing of stamps as taught and claimed by Applicant.

Applicant is arguing amended claim which is responded to in response to the claims.

In response to applicant's argument that Stephens reference is directed to the placement of a personal image on a tab adjacent an official stamp. There is no teaching

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or suggestion of providing on-line services or providing instructions to a remote location as taught and claimed by Applicant.

Applicant is arguing amended claim which is responded to in response to the claims.

In response to applicant's argument that Brasington et al. is simply directed to a vending machine where there is clearly no teaching or suggestion of an on-line service of obtaining instructions or the ability to review and authorize use of personal images on postal stamps.

Applicant is arguing amended claim which is responded to in response to the claims.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 – 4, 6 – 12, 15 – 26 and 29 – 32, 34 – 51 and 55 are rejected under 35 USC 103(a) as being unpatentable over United States Postal Service hereinafter known

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as USPS in view of an article by Glen Stephens teaching personalized postage stamps at Australia 99 World Stamps Expo hereinafter known as Stephens, and further in view of an article by Marilyn J. Brackney hereinafter known as Brackney and Microsoft Paint and Brasington et al. US Patent 5,923,406 hereinafter known as Brasington.

Regarding claims 1, 32, 42 and 49 – 50, USPS discloses system and method for ordering a Official Postal Stamp. USPS discloses a central authorizing computer system for communicating with remote ordering system over a communication network, it is obvious that USPS computer system has a computer program for allowing customers to order Official Postal Stamp.

USPS does not disclose ordering customized postal stamp. Stephens teaches that on 19-24 March 1999 at “Australia 99” World Stamp Expo, audience could purchase a sheet of 10 stamps of personalized postage stamps. It would have been obvious to one of ordinary skill in the art that Stephens has a display device for displaying information on a user interface and data entry mean for getting input form user for enabling a user to communicate with the system. Neither USPS nor Stephens discloses allowing customers to forward image to the issuing authority. Brackney teaches system and method to design a postage stamp for Black History Month (image provided for the stamp). Brackney discloses that image can be transferred in electronic form [page 2, email the image].

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Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to allow customers to order personalized postage stamps from USPS.

It would have been obvious to one of ordinary skill in the art at the time invention was made that the users are known to use personal computers with Microsoft Windows for communicating with vendor computers for placing orders over the internet. Microsoft Paint is a tool available with Microsoft Windows operating system which a user can use for generating and manipulating images. It is known at the time of invention to a person with ordinary skill in the art the tools available by Microsoft operating system can be used by the product developer to reuse the tool readily available and minimize development costs. For example, calculator tool which comes with Microsoft Windows is used for providing calculator interface to the user.

USPS in view of Stephens does not teach user providing an image for incorporation as an integral part of said official postal stamp. However, Stephens teaches connected (undivided) official postal stamp. Brasington teaches system and method for user providing an image for incorporation as an integral part of postal stamp (providing personalized postage stamp) [Fig. 5].

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify USPS in view of Stephens as taught by Brasington to produce a postal stamp which does not break off and lose its collector item value.

USPS in view of Stephens and Brackney teaches ordering of customized postal stamp at remote ordering system based on instructions and user selections options provided by central authorizing system (as responded to earlier Brackney and Stephens teaches stamps can be customized and USPS teaches stamps can be ordered over a communication network)

Regarding claim 2, it would have been obvious to one of ordinary skill in the art at the time the invention was made that remote ordering system comprises a microprocessor having communication software to be able to communicate with USPS over the communication network.

Regarding claim 4, USPS in view of Stephens and Brackney teaches instruction on how to modify (create) and image for use on postal stamp [Brackney, page 1,2].

Regarding claim 3, it is a user choice whether to use a personal computer like Windows based PCs, Apple MacIntosh etc., or to use workstations like Sun, HP, IBM RS/6000 etc. to be able to communicate with USPS over the communication network.

Regarding claim 6, USPS discloses acceptable criteria for image content of images that can be used on official postal stamp. Brackney discloses that USPS has Criteria For Stamp Subject Selection [page 2, pp 3].



Regarding claim 7, USPS discloses customers can order of plurality of images already available from USPS [page 14]. In addition, it is known to one of ordinary skill in the art at the time the invention was made that online ordering systems and method can save information to be used for future ordering. For example, One-Click ordering.

Regarding claims 8, 38 and 48 USPS does not disclose uploading of image. However, Brackney, discloses that image can be uploaded in an electronic form. As responded to earlier in response to claims 1, 32, 42 and 49 – 50, it would have been obvious to one of ordinary skill in the art that Stephens has a display device for displaying information on a user interface and data entry mean for getting input from user for enabling a user to communicate with the system.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to allow users to upload the information to save on cost associated with scanning the images.

Regarding claim 9 and 45, USPS does not disclose allowing customizing (modification) of prestored information by the user. However, it is known to one of ordinary skill in the art at the time the invention was made that online ordering systems and method which allows users to change the prestored information to make the system flexible to allow customers to make changes.

Regarding claim 10, USPS does not disclose computer program to have means for making changes to (customizing) information. It would have been obvious to one of ordinary skill in the art at the time the invention was made that in order to allow users to make changes to information, the system has means to allow user to provide information to the system.

Regarding claims 11 – 12, USPS does not disclose modifying the shape, size, color, or orientation of the said image, it is obvious that when a user modifies an image, they modify the image to their desire, and, within the guidelines of the servicing business (for example, within the guidelines of the post office).

Regarding claim 15, USPS discloses postal stamps to have denominations for postal stamps. USPS does not disclose denominations for postal stamps. Stephens disclose Australia Post issuing a sheet of 10 personalized postage stamps of 45 cents each. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made that postal authority issue stamps of predefined schedule to ensure that the stamps has the value as per the postal authority charge schedule.

Regarding claim 16, USPS discloses customers purchasing postal products from USPS with the denominations printed on the postal stamps. It would have been obvious to one of ordinary skill in the art at the time the invention was made that USPS modifies

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denominations on postal products when the denomination schedule changes to ensure that it is charging the correct postage to consumers.

Regarding claims 17 and 34, USPS discloses that customers can purchase postal stamps online [page 14]. USPS does not disclose providing electronic order form. It would have been obvious to one of ordinary skill in the art at the time invention made that online shopping systems provide an electronic order form for completion at customer's ordering system and transmitting the completed form to vendors computer system to gather the information from the user (USPS teaches ordering Postal stamps from remote location over the internet). For example, online shopping at Amazon.com providing online shopping over the internet at the time of invention, which provided an electronic order form for allowing customers to place orders, provided receipts for orders placed by the customers.

Regarding claim 18, USPS does not disclose providing notification. However, it would have been obvious to one of ordinary skill in the art at the time invention was made to provide notification to user to inform the user that the transaction has been accepted.

Regarding claim 19 USPS does not discloses order form to include means for providing payment. However, it would have been obvious to one of ordinary skill in the art at the time invention was made to provide means to allow customer to provide

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payment information to allow customer to make payment at the time of purchase and minimize cost of billing the customer.

Regarding claims 20 – 21, USPS does not disclose order form and its contents. However, it would have been obvious to one of ordinary skill in the art at the time invention was made to that order forms are known to include contact information like customer information, phone number, address, e-mail address.

Regarding claims 22, 35 and 44 USPS does not disclose creating a receipt of order form. However, it would have been obvious to one of ordinary skill in the art at the time invention was made to create receipt from transactions to inform the customer of what they have ordered, what the charges are, and complete the order (USPS teaches remote ordering which is an electronic order).

Regarding claims 23, 36 and 46 it is a design choice to elect what the content of the receipt should look like. For example, confirmation receipt from fax machines, some receipts include image of first page of the fax sent.

Regarding claim 24, USPS does not disclose notifying customer over the communication network about status of their order. However, it would have been obvious to one of ordinary skill in the art at the time invention was made to notify

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customer over the mode of transaction from vendor to customer the status of their order to keep the customer informed about their order.

Regarding claim 25, USPS does not disclose order identification number. However, it would have been obvious to one of ordinary skill in the art at the time invention was made to have order identification number to differentiate between orders.

Regarding claim 26, USPS does not disclose printing device. It would have been obvious to one of ordinary skill in the art at the time invention was made that USPS has printing device to print the postal stamps. Also, it would have been obvious to one of ordinary skill in the art at the time invention was made that at Australia 99, Australia Post had printed device to print the personalized postal stamps.

Regarding claim 29, USPS does not disclose means for manipulation of image. Brackney discloses that contents of a stamp can be generated and submitted in electronic form. A user can use tool like Microsoft Paint to generate an image, manipulate image etc., and transfer the updated image in an electronic form to the supplier like USPS. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have means for manipulation of image to avoid cost associated with scanning of modified images.

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Regarding claims 30 and 51, it would have been obvious to one of ordinary skill in the art at the time invention was made that Microsoft Paint (available with Windows 95) has selection button for incrementally moving the image a predetermined incremental amount in at least one direction.

Regarding claim 31, it is a design choice to elect how large an image can be enlarged.

Regarding claims 37 and 47, USPS does not disclose reviewing image at remote computer system prior to uploading image to said central authorizing computer system. USPS discloses to have guidelines for images on postal stamps. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to review the image prior to submitting image to USPS to ensure that the image will be approved for imprinting on the postage stamp.

Regarding claim 39, USPS discloses to have guidelines for images on postal stamps. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to obtain approval for image to be printed on the postal stamp to ensure that the image has met the USPS guidelines for imprinting on the postage stamp.

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Regarding claim 40, USPS discloses printing of postage stamp. Also, Stephens teaches that at Australia 99 World Stamp Expo, Australia Post teaches to print approved (stamp images meeting guidelines) personalized postage stamp.

Regarding claim 41, USPS does not disclose allowing users to check status of order. However, it would have been obvious to one of ordinary skill in the art at the time invention was made to allow users to check status of order placed online to make the system self sufficient, save on personnel cost associated with supporting customer calling in to check order status etc.

Regarding claim 43 USPS discloses to provide selections to user. USPS does not disclose to provide instructions to user. It is known to one of ordinary skill in the art at the time the invention was made to that online ordering systems provide instructions to customers on how to use the system for ordering the products to make the system to take orders without minimum human intervention (system is self sufficient) and save on personnel cost.

Regarding claims 55, USPS discloses system and for ordering a Official Postal Stamp. USPS discloses a central authorizing computer system for communicating with remote ordering system over a communication network, it is obvious that USPS computer system has a computer program for allowing customers to order Official Postal Stamp.

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USPS does not disclose ordering custom postal stamp. Stephens teaches that on 19-24 March 1999 at "Australia 99" World Stamp Expo, audience could purchase a sheet of 10 stamps of personalized postage stamps. it would have been obvious to one of ordinary skill in the art that Stephens has a display device for displaying information on a user interface and data entry mean for getting input from user for enabling a user to communicate with the system. Neither USPS nor Stephens discloses allowing customers to forward image to the issuing authority. Brackney teaches system and method to design a postage stamp for Black History Month (image provided for the stamp). Brackney discloses that image can be transferred in electronic form [page 2, email the image]. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to allow customers to order personalized postage stamps from USPS.

It would have been obvious to one of ordinary skill in the art at the time invention was made that the users are known to use personal computers with Microsoft Windows for communicating with vendor computers for placing orders over the internet. Microsoft Paint is a tool available with Microsoft Windows operating system which a user can use for generating and manipulating images. It is known at the time of invention to a person with ordinary skill in the art the tools available by Microsoft operating system can be used by the product developer to reuse the tool readily available and minimize development costs. For example, calculator tool which comes with Microsoft Windows is used for providing calculator interface to the user. USPS discloses allowing users to order stamps with prestored images [page 14].



USPS teaches order of postal stamps.

Claims 13 – 14 are rejected under 35 USC 103(a) as being unpatentable over United States Postal Service hereinafter known as USPS in view of an article by Glen Stephens teaching personalized postage stamps at Australia 99 World Stamps Expo hereinafter known as Stephens, and further in view of an article by Marilyn J. Brackney hereinafter known as Brackney, Microsoft Paint, Brasington et al. US Patent 5,923,406 hereinafter known as Brasington and Kara US Patent 5,819,240.

Regarding claims 13 – 14, USPS discloses text on postal stamps. USPS does not disclose providing text for prestored images. Kara teaches to provide a menu of postage indicia that can be selected by the customer for particular occasions. The user is able to create or select one of a variety of graphical configurations of postage indicia to be imprinted as the postage meter stamp on a piece of mail. User can also personalize postage indicia. In addition, the user is provided with a message box to allow the user to add an optional message or greeting (e.g., "Happy Holidays") to be printed next to the meter stamp. This message may be changed at any time by the user, directly or by a "merge" command in conjunction with a word processing or graphics program coupled to the E-STAMP program. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to allow users to print personalized message.

Claim 28 is rejected under 35 USC 103(a) as being unpatentable over United States Postal Service hereinafter known as USPS in view of an article by Glen Stephens teaching personalized postage stamps at Australia 99 World Stamps Expo hereinafter known as Stephens, and further in view of an article by Marilyn J. Brackney hereinafter known as Brackney, Microsoft Paint and Brasington et al. US Patent 5,923,406 hereinafter known as Brasington.

Regarding claim 28, USPS does not disclose portion of the custom image is combined with a prestored image. Brasington discloses personalized postage stamp including predetermined data required by postal authority [abstract]. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine custom image with predetermined data to ensure that the stamp has the date required by postal authority.

Claim 52 – 54 are rejected under 35 USC 103(a) as being unpatentable over United States Postal Service hereinafter known as USPS in view of an article by Glen Stephens teaching personalized postage stamps at Australia 99 World Stamps Expo hereinafter known as Stephens, and further in view of an article by Marilyn J. Brackney

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hereinafter known as Brackney, Microsoft Paint, Brasington et al. US Patent 5,923,406 hereinafter known as Brasington and Mold US Patent 5,9978,772.

Regarding claims 52 – 54, USPS discloses system and for ordering a Official Postal Stamp. USPS discloses a central authorizing computer system for communicating with remote ordering system over a communication network, it is obvious that USPS computer system has a computer program for allowing customers to order Official Postal Stamp.

USPS does not disclose ordering custom postal stamp. Stephens teaches that on 19-24 March 1999 at "Australia 99" World Stamp Expo, audience could purchase a sheet of 10 stamps of personalized postage stamps. it would have been obvious to one of ordinary skill in the art that Stephens has a display device for displaying information on a user interface and data entry mean for getting input form user for enabling a user to communicate with the system. Neither USPS nor Stephens discloses allowing customers to forward image to the issuing authority. Brackney teaches system and method to design a postage stamp for Black History Month (image provided for the stamp). Brackney discloses that image can be transferred in electronic form [page 2, email the image]. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to allow customers to order personalized postage stamps from USPS.

It would have been obvious to one of ordinary skill in the art at the time invention was made that the users are known to use personal computers with Microsoft Windows

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for communicating with vendor computers for placing orders over the internet. Microsoft Paint is a tool available with Microsoft Windows operating system which a user can use for generating and manipulating images. It is known at the time of invention to a person with ordinary skill in the art the tools available by Microsoft operating system can be used by the product developer to reuse the tool readily available and minimize development costs. For example, calculator tool which comes with Microsoft Windows is used for providing calculator interface to the user.

USPS does not disclose means for manipulation of image. Brackney discloses that contents of a stamp can be generated and submitted in electronic form. Official notice it taken that it would have been obvious to one of ordinary skill in the art at the time the invention was made that a user can use tool like Microsoft Paint (commercially available at the time the invention was made) to generate an image, manipulate image etc., and transfer the updated image in an electronic form to the supplier like USPS. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have means for manipulation of image to avoid cost associated with scanning of modified images.

USPS teaches placement of an order with authorizing computer.

USPS does not disclose creating a receipt of order form. However, it would have been obvious to one of ordinary skill in the art at the time invention was made to create receipt from transactions to inform the customer of what they have ordered, what the charges are, and complete the order.

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USPS does not disclose printing barcode on the receipt. However, Mold teaches a receipt with the barcode printed on a receipt. Therefore, it is known at the time of invention to a person with ordinary skill in the art to print barcode on the receipt to expedite the sales process by minimizing the customer service representative or the customer to manually enter the order number for checking the status, picking up the order etc.

USPS does not disclose barcode reader. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a barcode reader should the business decide to implement barcode identification to be able to read the barcode and minimize keyboard entry.

### ***Conclusion***

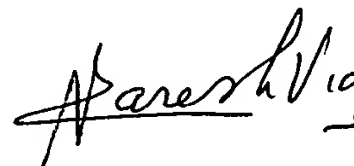
Applicant is required under 37 CFR '1.111 (c) to consider the references fully when responding to this office action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Naresh Vig whose telephone number is (571) 272-6810. The examiner can normally be reached on M-F 7:30 - 6:00 (Wednesday off).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Naresh Vig  
Examiner  
Art Unit 3629

November 4, 2005